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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,858	06/27/2003	Alan Michael Jaffee	7304	7146
7590 JOHNS MANVILLE Legal Department 10100 West Ute Avenue Littleton, CO 80127			EXAMINER CHOL, PETER Y	
			ART UNIT 1794	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/607,858

**Applicant(s)**

JAFEE, ALAN MICHAEL

**Examiner**

PETER Y. CHOI

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-15, 17-27, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-15, 17-27, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 21, 2009, has been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-6, 8-15, 17-27, 31, and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1-6, 8-15, 17-27, 31, and 32, claims 1, 27 and 32 recite that the surface texture does not remain perceptible after the first face is painted. Applicant's specification as originally filed does not provide support for such a limitation.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-6, 8-15, 17-27, 31, and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-6, 8-15, 17-27, 31, and 32, claims 1, 27 and 32 recite that the first face of the board has a smoothness that is sufficient to permit the board to be directly paintable. It is unclear exactly what the scope of claim necessarily entails, as Applicant's specification does not provide objective and/or quantitative characteristics which describe a "smoothness that is sufficient to permit the board to be directly paintable," such that the scope of the claim is necessarily definite. For example, Applicant does not provide characteristics and/or measurable differences between a "sufficient" smoothness and an "insufficient" smoothness and a relationship between smoothness and paintability, such that the scope of the claim is necessarily definite.

Additionally, regarding claims 1-6, 8-15, 17-27, 31, and 32, claims 1, 27 and 32 recite that the surface texture does not remain perceptible after the first face is painted. It is unclear what exactly the scope of the claim necessarily entails, as the perceptibility of the surface texture is based on a variety of process factors which are not claimed. For example, the perceptibility of the surface texture is subjective. Additionally, the perceptibility of the surface texture after the first face is painted, is based on the particular painting process and paints used. For example, the painting of the first face may vary based on the types of paints being used and based on the specific painting conditions, including the manner in which the paint is applied, such as spray-

coating and/or roll-coating, and the amount or thickness of the paint being applied. The type of paint and the process of coating necessarily give rise to different perceptibility results, since the perceptibility of the surface texture is dependent on the paint and the painting process.

Additionally, as shown in USPN 4,572,862 to Ellis, a painted fiberglass layer comprises varying surface textures based on the type of paint, the amount of paint, and the painting process (*see for example* Ellis, Abstract, column 1 line 8 to column 5 line 4, column 16 line 23 to column 17 line 12, Examples 1-4, claims 1-18). Therefore, the limitation directed to the surface texture not remaining perceptible after the first face is painted is indefinite.

#### ***Response to Arguments***

6. Applicant's arguments filed December 21, 2009, have been fully considered but they are not persuasive. Applicant argues that the skilled person would recognize that the requisite smoothness and paintability are discernible by observing whether or not the surface is smooth enough that the underlying fibrous texture of the mat facer is not readily perceived after the gypsum board employing that facer is painted so as to render the surface aesthetically objectionable. Examiner respectfully disagrees. First, it is still unclear what smoothness is within the scope of a "requisite smoothness" as Applicant does not provide any objective and/or quantitative characteristics associated with such a smoothness. Second, it is unclear how a surface is "aesthetically objectionable" when painted since aesthetics are subjective. Additionally, although Applicant recites page 4 of Applicant's specification as indicating the deficiency of the prior art fiber-faced construction boards, Applicant does not provide definite characteristics of the claimed invention such that the scope of the claimed limitations are

definite. For example, it is unclear what “smoothness” is “sufficient” and/or within the scope of the claim as the limitations are subjective and/or qualitative. Similarly, it is unclear what the scope of a surface texture which is perceptible after the first face is painted necessarily entails, as the limitation is dependent on further characteristics and processes of painting which are not claimed and which directly relate to the perceptibility of the surface texture.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6, 8-15, 17-19, 21-24, 26, 27, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,772,846 to Jaffee.

Jaffee is directed to a nonwoven glass fiber mat for facing gypsum board (Title).

As to claims 1-6, 8-15, 17-19, 21-24, 26, and 31, Jaffee teaches a nonwoven fibrous mat for use as a facer on a gypsum insulating board (see entire document including column 1 lines 6-67, column 2 line 2 to column 4 line 56, Examples 1-4). Jaffee teaches that the mat comprises a major portion of textile glass fibers and may comprise a minor portion of other fibers (column 2 lines 34-61). Jaffee teaches that the nonwoven mat is bound together with a latex (column 2 line 2 to column 4 line 56). The Examiner equates the latex to Applicant’s “resinous binder”. Jaffee teaches that the glass fibers can have a length between 0.25 and 1 inch which is equal to 6.35-25.4 mm (column 3 lines 34-61). Examiner equates this short length to Applicant’s “chopped

glass fibers". Jaffee teaches that the glass fibers have an average diameter from about 9 $\mu$ m to 20 $\mu$ m (column 3 lines 34-61). Jaffee states that it is known to face a gypsum wall board with a fiber glass nonwoven mat as shown in USPN 4,647,496, the disclosure of which is hereby incorporated by reference. It should be noted that the phrase "incorporated by reference" means that the information incorporated is as much a part of patent as if the text was repeated in the patent, and should be treated as part of the text of the patent. Therefore, although not explicitly shown in Jaffee, the incorporated USPN 4,647,496 shows in Figure 8 that the nonwoven fibrous mat facing materials are applied to both sides of the gypsum board and it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the gypsum board of the prior art with the construction as shown in USPN 4,647,496, since Jaffee teaches the suitability of the gypsum board with such a construction. It should be noted that both of the facing materials have the same composition. USPN 4,647,496 further teaches that the gypsum material is "set" (Abstract). Examiner equates the facing material applied to the first and second sides of the gypsum board as "first facer" and "second facer." It should be noted that the first face inherently comprises a surface texture, as the first face comprises a fibrous mat and fibrous mats necessarily comprise a surface having a surface texture.

In regards to the transitional phrase of "consisting essentially of", the phrase limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). The burden is upon Applicant to show that the additional components do affect the basic and novel characteristics of the invention. For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the

specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See MPEP 2111.03. Applicant may wish to amend the claim to use the transitional phrase “consisting of” which excludes any element, step, or ingredient not specified in the claim. For the purposes of examination at this time, Examiner will interpret “consisting essentially of” as “comprising”.

Regarding claims 1-6, 8-15, 17-19, 21-24, 26, and 31, Jaffee does not appear to teach that the chopped glass fibers have an average diameter of between about 9.5 and 12.5  $\mu\text{m}$  and an average fiber length ranging specifically from 6-12 mm as required by claims 1 and 22, that the glass fibers having a diameter of between 9.5-12.5  $\mu\text{m}$  comprise at least 90% by weight of the glass fibers as required by claim 4, at least 95% as required by claim 5, at least 97% by weight as required by claim 6, that the chopped glass fibers have a fiber length ranging from about 6-18mm as required by claim 8, and that the fibrous mat has a basis weight of about  $1.25 \pm 0.2$  pounds per 100 square feet as required by claim 19. However, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the fiber diameter, length, proportion of glass fibers and basis weight since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454 USPQ 233 (CCPA 1955). In the present invention, one would have been motivated to optimize the fiber diameter, length, proportion of glass fibers and basis weight in order to create a composite with the desired properties such as flexibility and strength while minimizing skin irritation during installation.



Additionally, it would have been obvious to one of ordinary skill in the gypsum board art at the time the invention was made to form the gypsum board of Jaffee, wherein the chopped glass fibers have an average diameter of between about 9.5 and 12.5  $\mu\text{m}$  and an average fiber length ranging from 6-12 mm, as Jaffee teaches that the chopped glass fibers can have average diameters from about 9 $\mu\text{m}$  to about 20 $\mu\text{m}$  and average lengths between 0.25 inches and 1 inch, and such a teaching would have indicated to one of ordinary skill in the art that all of the chopped glass fibers can have an average diameter and an average length within the claimed ranges.

Regarding claims 1-6, 8-15, 17-19, 21-24, 26, and 31, Jaffee does not specifically teach that the gypsum board is paintable, that the first facer provides the first face of the gypsum board with a smoothness that is sufficient to permit the gypsum board to be directly paintable, and that the surface texture does not remain perceptible after the first face is painted. For purposes of examination, "paintable" is interpreted as "capable of being painted." Although the prior art does not teach the claimed characteristics, the claimed characteristics are deemed to be inherent and/or appear to naturally flow from the teachings of the prior art, as the prior art teaches a substantially similar structure and composition (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range) as the claimed invention. Products of identical structure cannot have mutually exclusive properties. The burden is on the Applicant to prove otherwise.

Additionally and/or alternatively, the limitation directed to the surface texture not remaining perceptible after the first face is painted appears to recite an intended use of the first

face. For example, the limitation is interpreted as *when* the first face is painted, the surface texture will not remain perceptible. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since the prior art teaches a substantially similar structure and composition as the claimed invention (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range), the prior art appears capable of the claimed intended use. Additionally and/or alternatively, it would have been obvious to one of ordinary skill in the gypsum board art at the time the invention was made to form the gypsum board of the prior art, wherein the first face is not perceptible after the face is painted, motivated by the desire of finishing a gypsum board with paint and a painting process such that the face is smooth and comprises a uniform flat surface, based on the desired feel and aesthetics of the gypsum board.

Regarding claims 2 and 3, Jaffee teaches that the glass fibers can comprise any type of glass fibers, but E type, C type, T type and sodium borosilicate are preferred (column 3 lines 34-61).

Regarding claims 4-6, Jaffee teaches that the glass fibers have an average diameter from about  $9\mu\text{m}$  to  $20\mu\text{m}$  (column 3 lines 34-46). Jaffee teaches that the mat has a major portion of glass fibers and a may comprise a minor portion of glass or polymer fibers (Abstract). Jaffee further teaches that a minor portion of the glass fibers can have a diameter of  $0.4\text{-}2\mu\text{m}$  (column 3 lines 34-61).

Regarding claim 8, Jaffee teaches that the glass fibers can all have the same length (column 3 lines 34-61).

Regarding claim 9, Jaffee teaches that the latex, or “resinous binder”, comprises a crosslinkable vinyl chloride acrylate copolymer latex (column 3 line 61 to column 4 line 14). Jaffee states that an aqueous stearylated melamine emulsion can be added to the latex to act as an external crosslinker (column 4 lines 14-30). Therefore, it is the position of Examiner that the final product latex would be crosslinked as required by Applicant.

Regarding claim 10, Jaffee teaches that the latex, or resinous binder, comprises a crosslinkable vinyl chloride acrylate copolymer latex (column 3 line 61 to column 4 line 14) which is subsequently crosslinked (column 2 line 2 to column 4 line 56). It is the position of Examiner that the crosslinked latex is equivalent to Applicant’s “modified acrylic latex binder” because an acrylate is an acrylic.

Regarding claims 11-13, Jaffee teaches that the stearylated melamine emulsion, which acts as a crosslinker, is present in the amount of up to 10 weight percent (column 3 line 62 to column 4 line 37).

Regarding claim 13, Jaffee teaches that stearylated melamine emulsion is mixed with copolymer latex and formaldehyde to create a binder for the mats (column 3 line 62 to column 4 line 37, Examples 1-4).

Regarding claim 14, Jaffee teaches that the crosslinkable vinyl chloride acrylate copolymer latex has a glass transition temperature of up to 113 degrees F (column 3 line 62 to column 4 line 37). It should be noted that Applicant requires a glass transition temperature range of about 15 to 45 degrees Celsius (15-133 degrees F).

Regarding claim 15, Jaffee teaches that the stearylated melamine emulsion provides water repellency to the mat (column 4 lines 15-37).

Regarding claims 17-19, Jaffee teaches that the facer material or “fibrous mat” can weigh about 1.8 to 2.2 pounds per 100 square feet (column 3 lines 6-17).

Regarding claim 19, Jaffee teaches that the facer material or fibrous mat can preferably weigh about 1.8 to 2.2 pounds per 100 square feet (column 3 lines 6-17). Jaffee indicates that the mat can be any weight (column 3 lines 14-17).

Regarding claim 21, Jaffee teaches that the second facer comprises a fibrous mat (column 1 lines 6-67, column 2 line 2 to column 4 line 56, Examples 1-4; USPN 4,647,496, Figure 8).

Regarding claim 22, the second facer is a fibrous mat comprising a non-woven, glass fiber web bonded together with a resinous binder, and the glass fibers consist essentially of chopped glass fibers having an average fiber diameter ranging from about 9.5 to 12.5  $\mu\text{m}$  and an average fiber length ranging from about 6 to 12 mm (column 1 lines 6-67, column 2 line 2 to column 4 line 56, Examples 1-4; USPN 4,647,496, Figure 8).

Regarding claims 23 and 24, it should be noted that Jaffee states that it is known to face a gypsum wall board with a fiber glass nonwoven mat as shown in USPN 4,647,496, the disclosure of which was incorporated by reference. It should be noted that the phrase “incorporated by reference” means that the information incorporated is as much a part of patent as if the text was repeated in the patent, and should be treated as part of the text of the patent. Therefore, although not explicitly taught in Jaffee, the incorporated USPN 4,647,496 teaches that the gypsum core has water-resistant properties imparted by the incorporation of one or more additives (column 9

lines 49-60). USPN 4,647,496 also teaches that the gypsum board can further comprise a paper fiber which acts as a viscosity-control agent (column 13 lines 15-20).

Regarding claims 26 and 31, although Jaffee does not explicitly teach the claimed flame resistance to pass the test of ASTM Method E84, Class 1 as required by claim 26 and a permeability of at least 300 cfm/ft<sup>2</sup>, as required by claim 31, it is reasonable to presume that said properties are inherent and/or naturally flow from the teachings of the prior art. Support for said presumption is found in the use of like materials (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range) which would result in the claimed properties. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property would obviously have been present once the Jaffee product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

Regarding claim 27, Jaffee teaches a gypsum board having a first face and a second face and a non-woven fibrous mat affixed to at least one of the faces, the improvement wherein the mat comprises a glass fiber web bonded together with a resinous binder and the chopped glass fibers consist essentially of glass fibers having an average fiber diameter ranging from about 9.5 to 12.5µm and an average fiber length ranging from about 6 to 12 mm (see entire document including column 1 lines 6-67, column 2 line 2 to column 4 line 56, Examples 1-4). Additionally, Jaffee states that it is known to face a gypsum wall board with a fiber glass nonwoven mat as shown in USPN 4,647,496, the disclosure of which is hereby incorporated by reference. Therefore, although not explicitly shown in Jaffee, the incorporated USPN 4,647,496 shows in Figure 8 that the nonwoven fibrous mat facing materials are applied to both sides of the

gypsum board and it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the gypsum board of the prior art with the construction as shown in USPN 4,647,496, since Jaffee teaches the suitability of the gypsum board with such a construction. It should be noted that both of the facing materials have the same composition. USPN 4,647,496 further teaches that the gypsum material is “set” (Abstract). Examiner equates the facing material applied to the first and second sides of the gypsum board as “first facer” and “second facer”. It should be noted that the mat inherently comprises a surface texture, as the mat comprises a glass fiber web and glass fiber webs necessarily comprise a surface having a surface texture.

Regarding claim 27, Jaffee does not appear to teach that the chopped glass fibers have an average diameter of between about 9.5 and 12.5  $\mu\text{m}$  and an average fiber length ranging specifically from 6-12 mm. However, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the fiber diameter and length since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454 USPQ 233 (CCPA 1955). In the present invention, one would have been motivated to optimize the fiber diameter, length, proportion of glass fibers and basis weight in order to create a composite with the desired properties such as flexibility and strength while minimizing skin irritation during installation.

Additionally, it would have been obvious to one of ordinary skill in the gypsum board art at the time the invention was made to form the gypsum board of Jaffee, wherein the chopped glass fibers have an average diameter of between about 9.5 and 12.5  $\mu\text{m}$  and an average fiber

length ranging from 6-12 mm, as Jaffee teaches that the chopped glass fibers can have average diameters from about 9 $\mu$ m to about 20 $\mu$ m and average lengths between 0.25 inches and 1 inch, and such a teaching would have indicated to one of ordinary skill in the art that all of the chopped glass fibers can have an average diameter and an average length within the claimed ranges.

Regarding claim 27, Jaffee does not specifically teach that the mat provides the first face of the gypsum board with a smoothness that is sufficient to permit the gypsum board to be directly paintable, such that the surface texture does not remain perceptible after the first face is painted. For purposes of examination, "paintable" is interpreted as "capable of being painted." Although the prior art does not teach the claimed characteristics, the claimed characteristics are deemed to be inherent and/or appear to naturally flow from the teachings of the prior art, as the prior art teaches a substantially similar structure and composition (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range) as the claimed invention. Products of identical structure cannot have mutually exclusive properties. The burden is on the Applicant to prove otherwise.

Additionally and/or alternatively, the limitation directed to the surface texture not remaining perceptible after the first face is painted appears to recite an intended use of the first face. For example, the limitation is interpreted as *when* the first face is painted, the surface texture will not remain perceptible. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is

capable of performing the intended use, then it meets the claim. Since the prior art teaches a substantially similar structure and composition as the claimed invention (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range), the prior art appears capable of the claimed intended use. Additionally and/or alternatively, it would have been obvious to one of ordinary skill in the gypsum board art at the time the invention was made to form the gypsum board of the prior art, wherein the first face is not perceptible after the face is painted, motivated by the desire of finishing a gypsum board with paint and a painting process such that the face is smooth and comprises a uniform flat surface, based on the desired feel and aesthetics of the gypsum board.

Regarding claim 32, Jaffee teaches a hydraulic set board, comprising a hydraulic set material layer having a first and a second face, and first and second facers affixed to the first and second faces, at least of the first facer being a fibrous mat comprising a non-woven, glass fiber web bonded together with a resinous binder, the glass fibers consisting essentially of chopped glass fibers having an average fiber diameter ranging from about 9.5 to 12.5 $\mu$ m and an average fiber length ranging from about 6 to 12mm (see entire document including column 1 lines 6-67, column 2 line 2 to column 4 line 56, Examples 1-4). Additionally, Jaffee states that it is known to face a gypsum wall board with a fiber glass nonwoven mat as shown in USPN 4,647,496, the disclosure of which is hereby incorporated by reference. It should be noted that the phrase “incorporated by reference” means that the information incorporated is as much a part of patent as if the text was repeated in the patent, and should be treated as part of the text of the patent. Therefore, although not explicitly shown in Jaffee, the incorporated USPN 4,647,496 shows in



Figure 8 that the nonwoven fibrous mat facing materials are applied to both sides of the gypsum board and it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the gypsum board of the prior art with the construction as shown in USPN 4,647,496, since Jaffee teaches the suitability of the gypsum board with such a construction. It should be noted that both of the facing materials have the same composition. USPN 4,647,496 further teaches that the gypsum material is “set” (Abstract) and the set material is within the scope of the claimed “hydraulic.” Examiner equates the facing material applied to the first and second sides of the gypsum board as “first facer” and “second facer”. It should be noted that the first facer inherently comprises a surface texture, as the first face comprises a fibrous mat and fibrous mats necessarily comprise a surface having a surface texture.

Regarding claim 32, Jaffee does not appear to teach that the chopped glass fibers have an average diameter of between about 9.5 and 12.5  $\mu\text{m}$  and an average fiber length ranging specifically from 6-12 mm. However, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the fiber diameter and length since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454 USPQ 233 (CCPA 1955). In the present invention, one would have been motivated to optimize the fiber diameter, length, proportion of glass fibers and basis weight in order to create a composite with the desired properties such as flexibility and strength while minimizing skin irritation during installation.

Additionally, it would have been obvious to one of ordinary skill in the gypsum board art at the time the invention was made to form the gypsum board of Jaffee, wherein the chopped

glass fibers have an average diameter of between about 9.5 and 12.5  $\mu\text{m}$  and an average fiber length ranging from 6-12 mm, as Jaffee teaches that the chopped glass fibers can have average diameters from about 9 $\mu\text{m}$  to about 20 $\mu\text{m}$  and average lengths between 0.25 inches and 1 inch, and such a teaching would have indicated to one of ordinary skill in the art that all of the chopped glass fibers can have an average diameter and an average length within the claimed ranges.

Regarding claim 32, Jaffee does not specifically teach that the first facer provides the first face of the hydraulic set board with a smoothness that is sufficient to permit the hydraulic set board to be directly paintable, such that the surface texture does not remain perceptible after the first face is painted. For purposes of examination, “paintable” is interpreted as “capable of being painted.” Although the prior art does not teach the claimed characteristics, the claimed characteristics are deemed to be inherent and/or appear to naturally flow from the teachings of the prior art, as the prior art teaches a substantially similar structure and composition (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range) as the claimed invention. Products of identical structure cannot have mutually exclusive properties. The burden is on the Applicant to prove otherwise.

Additionally and/or alternatively, the limitation directed to the surface texture not remaining perceptible after the first face is painted appears to recite an intended use of the first face. For example, the limitation is interpreted as *when* the first face is painted, the surface texture will not remain perceptible. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since the prior art teaches a substantially similar structure and composition as the claimed invention (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range), the prior art appears capable of the claimed intended use. Additionally and/or alternatively, it would have been obvious to one of ordinary skill in the gypsum board art at the time the invention was made to form the gypsum board of the prior art, wherein the first face is not perceptible after the face is painted, motivated by the desire of finishing a gypsum board with paint and a painting process such that the face is smooth and comprises a uniform flat surface, based on the desired feel and aesthetics of the gypsum board.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffee, as applied to claims 1-6, 8-15, 17-19, 21-24, 26, 27, 31, and 32 above, in view of USPN 6,187,697 to Jaffee (herein referred to as "'697").

Regarding claim 13, the prior art appears to teach that the resinous binder comprises melamine formaldehyde. Additionally, Jaffee teaches that the binder may comprise crosslinked vinyl chloride acrylate copolymer, a cross-linker, and urea formaldehyde (*see for example* Jaffee, Examples 1-4). Additionally, '697 teaches a substantially similar facer suitable for use with gypsum board, the facer comprising a non-woven glass fiber web bonded with a resinous binder, the glass fibers having an exemplary diameter of 10 $\mu$ m and having an exemplary length of about 0.25 inches, wherein the binder comprises urea formaldehyde or melamine formaldehyde ('697,

column 1 line 4 to column 3 line 5, column 3 lines 17-35, column 5 lines 26-60, column 6 line 65 to column 7 line 12). It would have been obvious to one of ordinary skill in the gypsum board facer art at the time the invention was made to form the facers of the prior art, wherein the binder comprises melamine formaldehyde, as taught by '697, motivated by the desire of forming a conventional gypsum board with facers comprising binders known in the art to be suitable and functionally equivalent in the gypsum board facer art, and the simple substitution of one known binder for another would yield predictable results.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffee, as applied to claims 1-6, 8-15, 17-19, 21-24, 26, 27, 31, and 32 above, in view of USPN 6,365,533 to Horner.

Jaffee teaches the claimed invention above but fails to disclose that the second facer can comprise kraft paper.

Horner is directed to a foamed facer suitable for use in the construction industry comprising a dry preformed glass fiber mat containing a binder (Abstract). Horner teaches that the first and second facers can be of the same or of a different composition than that of this invention. More specifically, one of the facer sheets maybe be selected from those conventionally employed such as kraft paper and the other facer sheet is one of the current invention which enhances the composite (column 6 lines 1-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a kraft paper as one of the facer materials as suggested by Horner in the gypsum

board composite of Jaffee motivated by the desire to save manufacturing costs by employing a conventional facer on one side and the improved and enhanced facer on the other side.

11. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffee, as applied to claims 1-6, 8-15, 17-19, 21-24, 26, 27, 31, and 32 above, in view of USPN 7,056,582 to Carbo.

Jaffee teaches the claimed invention but fails to teach that the core may further comprise a biocide. Carbo is directed to a mold resistant acoustical panel (Title). Carbo teaches, during manufacture of the panels, the zinc pyrithione is added to the slurry of water, fillers and binders that is used to form the panel. It is particularly surprising that the pyrithione salt added to the core protects both the panel core and the coating material. The panels of the present invention having zinc pyrithione incorporated only in the core exhibit improved mold resistance to an extent that would not be expected by incorporation of the zinc pyrithione into the core only. Regardless of the actual mechanism, biocides that display this behavior are useful in the acoustical panels of this invention (column 5 lines 25-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a biocide into the core of Jaffee as suggested by Carbo motivated by the desire to create a mold resistant panel.

#### ***Response to Arguments***

12. Applicant's arguments filed December 21, 2009, have been fully considered but they are not persuasive. It should be noted that Applicant's submissions of December 21, 2009, do not appear to comply with 37 CFR 1.4(d)(2)(i) which recites,

“The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation, and the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (e.g., /Dr. James T. Jones, Jr./).”

Applicant argues that Jaffee fails even to recognize the possibility of a faced gypsum board that has a surface that is smooth enough to be directly paintable. Examiner respectfully disagrees. The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. MPEP 2123. Additionally, the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference.

Jaffee teaches a nonwoven glass fiber mat for facing gypsum board (Title) comprising E glass fibers having average diameter from about 9 $\mu$ m to about 20 $\mu$ m, preferably from about 10 $\mu$ m to about 16 $\mu$ m (column 3 lines 33-46). The fiber lengths may be 0.25 inches to 1.0 inch, which is equivalent to 6.35 mm to 25.4 mm. Therefore, Jaffee renders obvious the claimed facer. Additionally, as set forth above, the prior art does not appear to specifically teach that the board is paintable and that the first facer provides the first face of the gypsum board with a smoothness that is sufficient to permit the gypsum board to be directly paintable. Although the prior art does not teach the claimed characteristics, the claimed characteristics are deemed to be

inherent and/or appear to naturally flow from the teachings of the prior art, as the prior art teaches a substantially similar structure and composition (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range) as the claimed invention. Products of identical structure cannot have mutually exclusive properties. The burden is on the Applicant to prove otherwise.

Additionally, it is well-settled that unsupported arguments are not a substitute for objective evidence. *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Applicant has not shown that the facer of the prior art is necessarily outside the scope of the claimed invention.

Applicant argues that the combination of the particular ranges of average fiber diameter between 9.5 and 12.5 $\mu$ m and average fiber length between 6 and 12 mm gives rise to surprising and unexpected results, as evidence in comparative examples set forth in the original specification and in two Declarations. Examiner respectfully disagrees. Applicant's arguments are moot as they were previously addressed by the Board of Patent Appeals & Interferences (herein "BPAI") in the BPAI Decision of January 29, 2009. The BPAI's arguments and conclusions are set forth below.

" First, Jaffee has not established that the test using camera images, software and visual observation is an art recognized test or is reliable. Also, only one test was carried out for each fiber diameter and length, and Jaffee has not established that the test is repeatable. Moreover, the cause-and- effect relationship between standard error and surface smoothness is lost in a multiple unfixed variables. *See In re Heyna*, 360 F.2d 222,228 (CCPA 1966); *In re Dunn*, 349 F.2d 433,439 (CCPA 1965). Jaffee changed not only the average fiber diameter and length, but also the average intensity (Decl. I: ¶ 14). If, for samples 1 and 4, the same standard deviation were obtained at the 1837 average intensity used for the Appellant's inventive sample 2, the standard errors would be, respectively, 7.9%

and 7.8%, which are very close to the 7.6% for the Appellant's inventive sample 2.

“Second, it is not enough for the Appellant to show that the results for the Appellant's invention and the comparative examples differ. The difference must be shown to be an unexpected difference. *See In re Freeman*, 474 F.2d 1318, 1324 (CCPA 1973); *In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972). Jaffee states that one of ordinary skill in the art would have expected that a smoother surface would be obtained using a smaller fiber diameter (Decl. I, ¶ 17), but Jaffee has not established that one of ordinary skill in the art would not have expected a larger length to diameter ratio than that in sample 3 to produce a smoother surface.

“Third, the evidence is not commensurate in scope with the claims. *See In re Grasselli*, 713 F.2d 731,743 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035 (CCPA 1980). The Appellant's claim 1 encompasses average fiber diameters from about 9.5 to 12.5 microns, and average fiber lengths from about 6 to 12 mm, yet Jaffee provides only one sample at an average fiber diameter of 11 microns and an average fiber length of 12 microns. We find in the evidence of record no reasonable basis for concluding that mats made of fibers having the other average diameters and lengths encompassed by the Appellant's claims would behave as a class in the same manner as the particular sample tested. *See In re Lindner*, 457 F.2d 506, 508 (CCPA 1972); *In re Susi*, 440 F.2d 442, 445-46 (CCPA 1971).

“The Appellant has not shown reversible error in the Examiner's determination that the Appellant's Declarations fail to overcome the prima facie case of obviousness”

(*See BPAI Decision of January 29, 2009, pages 7-9*).

Therefore, Applicant's arguments are not persuasive.

Additionally, the BPAI Decision of January 29, 2009, previously addressed the obviousness of the claimed fiber diameter range. The BPAI's arguments and conclusions are set forth below.

“ Claim 4 requires that at least about 90 wt% of chopped glass fibers have a diameter ranging between about 9.5 and 12.5 microns.

“The Appellant argues that there is no disclosure in Jaffee that calls for a narrow range of fiber diameters (Br. 47-48).

“Jaffee's disclosure that the glass fibers are chopped glass fibers and typically have average diameters from about 9 microns to about 20 microns (col.



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3, 11.38-39; col. 4, 1.67) would have indicated to one of ordinary skill in the art that all of the chopped glass fibers can have an average diameter within that range which includes the Appellant's range of between about 9.5 and 12.5 microns.

"The Appellant has not shown reversible error in the Examiner's determination that Jaffee would have rendered the invention claimed in the Appellant's claims 4, 26, 29, and 31 prima facie obvious to one of ordinary skill in the art"

(See BPAI Decision of January 29, 2009, pages 3-9).

Therefore, Applicant's arguments are not persuasive as the prior art renders obvious the claimed invention.

Applicant argues that nothing in Jaffee pertains in any way to smoothness or instructs the artisan how to "dial up" smoothness. Examiner respectfully disagrees. It should be noted that Applicant's recitation of smoothness and paintability are indefinite for the reasons set forth above. Additionally, as set forth in Applicant's arguments of December 21, 2009, page 9,

"Surprisingly and unexpectedly, gypsum board faced in accordance with the invention with the present nonwoven glass fiber mat, wherein the fibers consist essentially of chopped glass fibers having an average fiber diameter ranging from about 9.5 to 12.5 gm and an average fiber length ranging from about 6 to 12 mm, has a smoother surface than boards made with mats employing either larger or smaller diameter fibers. The smoothness of the surface permits the board to be painted directly, without the need for a skim coat of plaster, that heretofore has been required in order for the underlying surface texture of the mat not to be perceived after painting."

Based on Applicant's arguments, the claimed smoothness which Applicant argues is directly attributable to the combination of the chopped glass fibers having the claimed average fiber diameter and average fiber length. Applicant does not attribute or claim any other limitation which influences the claimed smoothness. Therefore, since the prior art renders obvious the claimed facer, including the claimed average fiber diameter and average fiber length,

it is reasonable for one of ordinary skill in the art to expect that the facer of the prior art necessarily and/or inherently comprises the claimed smoothness, absent evidence to the contrary.

Regarding Applicant's arguments that the possibility of smoothness and imperceptible mat structure were not properties ever contemplated by the prior art, the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. Since the prior art teaches a substantially similar structure and composition as the claimed invention, the prior art renders obvious the claimed invention.

Applicant argues that there is no basis that the resulting mat and board would exhibit improved smoothness. Examiner respectfully disagrees, as Applicant's arguments are not commensurate in scope with the claimed invention. Applicant neither claims an improved smoothness, nor any objective and/or quantitative characteristics of smoothness which necessarily differentiates the claimed invention from the prior art.

Applicant argues that Examiner has not articulated any basis that would establish that Applicant's choice of fiber dimensions would improve flexibility and strength and minimize skin irritation. Examiner respectfully disagrees. As set forth above, the prior art renders obvious the claimed facer, including the claimed fiber diameters and fiber lengths based on the totality of the teachings of the prior art. Additionally, the prior art teaches the suitability of such fiber diameters and fiber lengths, and that the nonwoven mat, when used as a facer, has improved handling characteristics, improved flame resistance, improved flexibility and produces less, or

less irritating, dust when the faced gypsum board is cut than the mats used heretofore for facing insulating gypsum board (Jaffee, column 2 lines 2-15). Therefore, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the fiber diameter, length, proportion of glass fibers and basis weight since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In the present invention, one would have been motivated to optimize the fiber diameter, length, proportion of glass fibers and basis weight in order to create a composite with the desired properties such as flexibility and strength while minimizing skin irritation during installation. Additionally, it would have been obvious to one of ordinary skill in the gypsum board art at the time the invention was made to form the gypsum board of Jaffee, wherein the chopped glass fibers have an average diameter of between about 9.5 and 12.5  $\mu\text{m}$  and an average fiber length ranging from 6-12 mm, as Jaffee teaches that the chopped glass fibers can have average diameters from about 9 $\mu\text{m}$  to about 20 $\mu\text{m}$  and average lengths between 0.25 inches and 1 inch, and such a teaching would have indicated to one of ordinary skill in the art that all of the chopped glass fibers can have an average diameter and an average length within the claimed ranges.

Applicant argues that Jaffee's Declaration must be regarded as being made by a person having at least ordinary skill, that the Jaffee Declaration of May 3 does not constitute objective evidence, that the BPAI's *sua sponte* position that Jaffee has not established that testing using camera images, software and visual observation is an art-recognized test or is reliable, and that the BPAI decision evidences a misreading of the May 3 Declaration with respect to the meaning

of the average intensity and standard error. Examiner respectfully disagrees. Applicant's arguments are moot as the BPAI Decision of January 29, 2009 has already addressed the substance and merits of the Declarations.

Applicant argues that not only is the claimed mat smoother, but also the smoothness is sufficient to permit direct painting without additional surface preparation. Examiner respectfully disagrees. As set forth above, "smoothness" is subjective and/or qualitative. Therefore, absent evidence that the prior art necessarily does not comprise a smoothness within the scope of the claimed invention, the prior art appears to disclose the claimed invention. Additionally, since the prior art renders obvious the claimed invention, including the claimed fiber diameters and fiber lengths, it is reasonable for one of ordinary skill in the art to expect that the facer of the prior art necessarily and/or inherently comprises the claimed smoothness, absent evidence to the contrary.

Applicant argues that the Jaffee Declaration establishes that at least some prior art gypsum boards falling within the board Jaffee disclosure fails to exhibit the requisite smoothness, thus negating any contention that such property is inherent. Examiner respectfully disagrees. As set forth above, since the prior art renders obvious the claimed invention, including the claimed fiber diameters and fiber lengths, it is reasonable for one of ordinary skill in the art to expect that the facer of the prior art necessarily and/or inherently comprises the claimed smoothness, absent evidence to the contrary. Additionally, as the BPAI Decision of January 29, 2009, has already addressed the substance and merits of the Declarations, Applicant's arguments directed to the Declarations are moot.

Applicant argues that the present structure is not substantially similar, given the narrow range of fiber diameter and length recited by the claims. Examiner respectfully disagrees.

Applicant's claimed fiber diameter and fiber length, and the teachings of the prior art in relation to the claimed fiber diameter and fiber length, has previously been addressed and is not repeated here.

Applicant argues that Examiner's reasoning in applying the excerpts from *KSR*, at pages 19 and 20 of the Final Rejection of September 22, 2009, is flawed. Examiner respectfully disagrees. The recitation of *KSR* establishes the scope of a 35 U.S.C. 103(a) rejection.

Applicant argues that nowhere does '697 teach fiber length and diameter in combination. Examiner respectfully disagrees. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. As set forth above, '697 is not relied on to teach the claimed fiber diameter and fiber length as Jaffee renders obvious each of the claimed fiber diameter and fiber length. Therefore, Applicant's arguments are not commensurate in scope with the current rejection.

As set forth above, '697 is relied on to teach that it was known in the gypsum board art to form a facer comprising a non-woven glass fiber web bonded with a resinous binder, wherein the binder comprises urea formaldehyde or melamine formaldehyde ('697, column 1 line 4 to column 3 line 5, column 3 lines 17-35, column 5 lines 26-60, column 6 line 65 to column 7 line 12). Therefore, it would have been obvious to one of ordinary skill in the gypsum board facer art at the time the invention was made to form the facers of the prior art, wherein the binder comprises melamine formaldehyde, as taught by '697, motivated by the desire of forming a conventional gypsum board with facers comprising binders known in the art to be suitable and

functionally equivalent in the gypsum board facer art, and the simple substitution of one known binder for another would yield predictable results.

Additionally, although Applicant reiterates that there is no proper teaching of a single mat having both the claimed fiber diameter and length, as set forth above, '697 is not relied on to teach the claimed fiber diameter and fiber length as Jaffee renders obvious each of the claimed fiber diameter and fiber length. Therefore, Applicant's arguments are not commensurate in scope with the current rejection.

Applicant argues that Horner fails to recognize the possibility of a gypsum or like construction board that is face with a non-woven, glass-fiber mat having a surface that is smooth enough to be directly paintable without the need for extensive surface preparation. Examiner respectfully disagrees. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. As set forth above, Horner is not relied on to teach the claimed gypsum board. Therefore, Applicant's arguments are not commensurate in scope with the current rejection. As set forth above, Horner teaches a facer suitable for use in the construction industry, particularly for insulation board manufacture, comprising a dry preformed fiber mat containing a binder for the fibers, preferably a preformed glass mat (*See* Horner, Abstract). Therefore, the prior art references are analogous art and properly combinable.

Applicant argues that Horner does not recognize paintability, and does not disclose or suggest the claimed fiber diameter range. Examiner respectfully disagrees. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

As set forth above, Horner is not relied on to teach the claimed gypsum board. Therefore, Applicant's arguments are not commensurate in scope with the current rejection.

Although Applicant argues that Horner does not recognize paintability, it is reasonable for one of ordinary skill in the art to presume that Applicant has not discovered paintability of facers for construction board. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. Since the prior art renders obvious the claimed fiber diameter range, and since the BPAI affirmed such a conclusion, and since Applicant argues that smoothness is related to the claimed fiber diameter and length ranges, such "smoothness" would naturally flow from the teachings of the prior art, absent evidence to the contrary.

Additionally, as set forth above, the prior art does not appear to specifically teach that the board is paintable and that the first facer provides the first face of the gypsum board with a smoothness that is sufficient to permit the gypsum board to be directly paintable. Although the prior art does not teach the claimed characteristics, the claimed characteristics are deemed to be inherent and/or appear to naturally flow from the teachings of the prior art, as the prior art teaches a substantially similar structure and composition (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range) as the claimed invention. Products of identical structure cannot have mutually exclusive properties. The burden is on the Applicant to prove otherwise.

Applicant argues that Carbo fails to recognize the possibility of a gypsum or like construction board faced with the claimed facers, having the claimed smoothness. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. As set forth above, Carbo is not relied on to teach the claimed gypsum board. Therefore, Applicant's arguments are not commensurate in scope with the current rejection.

As set forth above, although the prior art does not teach the claimed characteristics, the claimed characteristics are deemed to be inherent and/or appear to naturally flow from the teachings of the prior art, as the prior art teaches a substantially similar structure and composition (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range) as the claimed invention. Products of identical structure cannot have mutually exclusive properties. The burden is on the Applicant to prove otherwise. Additionally, as set forth above, it would have been obvious to one of ordinary skill in the gypsum board art at the time the invention was made to form the gypsum board of Jaffee, wherein the chopped glass fibers have an average diameter of between about 9.5 and 12.5  $\mu\text{m}$  and an average fiber length ranging from 6-12 mm, as Jaffee teaches that the chopped glass fibers can have average diameters from about 9 $\mu\text{m}$  to about 20 $\mu\text{m}$  and average lengths between 0.25 inches and 1 inch, and such a teaching would have indicated to one of ordinary skill in the art that all of the chopped glass fibers can have an average diameter and an average length within the claimed ranges. Therefore, based on Applicant's arguments, such "smoothness" would naturally flow from the teachings of the prior art, absent evidence to the contrary.



### ***Double Patenting***

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-6, 8-15, 17-27, 31, and 32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5, 7, 9, 11-14, 16-23, 25-29, and 31-33 of copending Application No. 10/608,790 to Jaffee. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 29, 32, and 33 of Jaffee similarly recites a gypsum layer or a hydraulic set material having a first face and a second face and comprising set gypsum, and first and second facers affixed to the first and second facers, the first facer being a fibrous mat comprising a non-woven bonded together with a resinous binder, the web comprising a blend of a major portion of chopped glass fibers having an average fiber diameter of about 9.5-12.5 $\mu$ m. Additionally, claim 7 of Jaffee recites glass fibers having an average fiber length ranging from about 6 to 12 mm. It

should be noted that the first face inherently comprises a surface texture, as the first face comprises a fibrous mat and fibrous mats necessarily comprise a surface having a surface texture.

Additionally, it should be noted that Jaffee claims various embodiments based on the dependent claims, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine embodiments and/or claimed limitations based on the totality of the disclosure of the claims, as such resulting structure would have been predictable.

Jaffee does not specifically teach that the gypsum board is paintable, that the first facer provides the first face of the gypsum board with a smoothness that is sufficient to permit the gypsum board to be directly paintable, and that the surface texture does not remain perceptible after the first face is painted. Although the prior art does not teach the claimed characteristics, the claimed characteristics are deemed to be inherent to the prior art as the prior art teaches a substantially similar structure and composition (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range) as the claimed invention. Products of identical structure cannot have mutually exclusive properties. The burden is on the Applicant to prove otherwise.

Additionally and/or alternatively, the limitation directed to the surface texture not remaining perceptible after the first face is painted appears to recite an intended use of the first face. For example, the limitation is interpreted as when the first face is painted, the surface texture will not remain perceptible. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since the prior art teaches a substantially similar structure and composition as the claimed invention (a gypsum layer and two face layers wherein the first facer comprising a nonwoven glass fiber web and resinous binder, wherein the glass fibers have an average diameter and length within the claimed range), the prior art appears capable of the claimed intended use. Additionally and/or alternatively, it would have been obvious to one of ordinary skill in the gypsum board art at the time the invention was made to form the gypsum board of the prior art, wherein the first face is not perceptible after the face is painted, motivated by the desire of finishing a gypsum board with paint and a painting process such that the face is smooth and comprises a uniform flat surface, based on the desired feel and aesthetics of the gypsum board.

Regarding the percentage of chopped glass fibers, Jaffee recites that the web includes a minor portion of glass or mineral fibers and comprising about 1-30 percent of the dry weight of the web. Since the minor portion may comprise 1-30 percent glass fibers, Jaffee teaches the claimed glass fiber percentages.

Jaffee recites identical and/or substantially similar chopped glass fibers (Jaffee, claims 2 and 3), resinous binders (Id., claims 18-23), cross-linker and cross-linker amounts (Id., claims 20-23), water repellant agent (Id., claim 25), biocide (Id., claim 26), reinforcing fiber (Id., claim 27), flame resistance (Id., claim 28), second facers (Id., claims 16 and 17), and air permeability (Id., claim 32), or that it would have been obvious to form the claimed board based on the desired characteristics of the predictably resulting board.

Regarding the basis weight of the fibrous mat, although Jaffee does not appear to claim the basis weight, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the board of the prior art, and determine a suitable basis weight based on the desired size, strength, thickness, and weight of the resulting board suitable for the intended application.

15. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER Y. CHOI whose telephone number is (571)272-6730. The examiner can normally be reached on Monday - Friday, 08:00 - 15:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Peter Y Choi/  
Examiner, Art Unit 1794